

78. The polypeptide of claim 63; wherein said polypeptide has at least 50 contiguous amino acid residues of the polypeptide encoded by the human cDNA in ATCC Deposit No. 97132. --

Remarks

Claims 39, 40, 41, 42, 45-47, and 57-78 will be pending upon entry of this amendment.

Claims 39, 40, 41 and 45-47 have been amended and claims 57-78 have been added, to more particularly point out and distinctly claim the subject matter Applicants regard as the invention. Support for the amendment to the claims and newly added claims is found throughout the specification as filed.

No new matter has been added.

I. Miscellaneous

a. The Restriction Requirement

Applicants affirm the April 2, 1998 oral election with traverse of Group I, drawn to polypeptides. The traversal is on the ground(s) that M.P.E.P. § 803 requires the examination of distinct or independent inventions in one application if the search and examination can be made without serious burden. Applicants submit that to search and examine the subject matter of all the Groups together (i.e., Groups I-VIII) would not be a serious burden on the Examiner. Accordingly, Applicants respectfully request that the Restriction Requirement Under 35 U.S.C. § 121 be withdrawn and the claims pending upon entry of this amendment be examined in one application.

II. Objections to the Claims

The Examiner has objected to claims 23-28, 30, 31, 33-35, 37 and 38, as being dependent upon a rejected base claim. Applicants have canceled all objected to and rejected claims. Accordingly, the Examiner's objection to the claims has been obviated and should be withdrawn.

III. Rejections under 35 U.S.C. § 112, first paragraph

a. The Examiner has rejected claims 22 and 29, under 35 U.S.C. § 112, first paragraph, for lack of enablement. More particularly, the Examiner alleges:

the specification, while being enabling for polypeptides having substitutions in amino acid sequence such that functional properties are not perturbed, does not reasonably provide enablement for polypeptides having substitutions where non-functional proteins are generated. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicants disagree and assert that the specification as filed, fully enables the entire scope of the polypeptides encompassed by the rejected claims. Nonetheless, solely in the interest of expediting prosecution, Applicants have canceled the rejected claims. Applicants point out that newly presented claim 65 and the claims dependent thereon, are directed to polypeptides that contain conservative amino acid residue substitutions of the recited amino acid sequence and that have a biological activity of the recited sequence. Accordingly, in view of the amendments and comments above, Applicants believe that this rejection under 35 U.S.C. § 112, first paragraph, has been overcome and respectfully request that the rejection be reconsidered and withdrawn.

b. The Examiner has rejected claims 21 and 32, under 35 U.S.C. § 112, first paragraph, for lack of enablement. More particularly, the Examiner alleges:

the specification, while being enabling for a polypeptide encoded by a polynucleotide which is degenerate relative to a naturally occurring polynucleotide, does not reasonably provide enablement for a polypeptide encoded by a polynucleotide which has 95% identity with all possible polynucleotides which are degenerate relative to a naturally occurring polynucleotide.

Applicants disagree. However, solely in the interest of expediting prosecution, Applicants have canceled the rejected claims. Applicants point out that none of the newly presented claims contain the language cited by the Examiner as allegedly being offensive. Accordingly, Applicants believe that this rejection under 35 U.S.C. § 112, first paragraph, has been overcome and respectfully request that the rejection be withdrawn.

Applicants expressly assert that claims 21-38, 43, 44, and 48-56 were canceled for the sole purpose of facilitating prosecution, and not in an effort to overcome any 35 U.S.C. § 112, first paragraph rejections. Applicants reserve the right to prosecute these claims in related applications.

In view of the amendments and comments above, Applicants believe that the rejections under 35 U.S.C. § 112, first paragraph, have been overcome and respectfully request that the rejections be withdrawn.

IV. Rejection Under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 21, 22, 29, 32 and 36 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. More particularly, the Examiner contends that:

Claims 21, 22, 29, 32 and 36 recite "...% identical". This phrase has unambiguous meaning when it is applied to the comparison of two sequences of equal length, however, sequences of unequal length are evidently considered to be comparable by this standard. It is not clear as to how gaps are to be assessed in determining identity where gaps are required to optimally align two sequences of unequal length.

Applicants disagree. However, solely in the interest of expediting prosecution, Applicants have canceled the rejected claims. Applicants point out that none of the newly presented claims contain the phrase "...% identical". Applicants expressly assert that these claims were canceled for the sole purpose of facilitating prosecution, and not in an effort to overcome this 35 U.S.C. § 112, second paragraph rejection. Applicants reserve the right to prosecute these claims in related applications.


Applicants assert that in view of the above amendments and remarks, the Examiner's rejection under 35 U.S.C. § 112, second paragraph, have been obviated or overcome and should be withdrawn.

V. Conclusion

Applicants respectfully request that the amendments and remarks of the present response be entered and made of record in the present application. The application is believed to be in condition for allowance. Early notice to that effect is earnestly solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution, the undersigned can be reached at the telephone number indicated below. If a fee is required in connection with this paper, please charge Deposit Account No. 08-3425 for the appropriate amount.

Respectfully submitted

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Kenley K. Hoover (Reg. No. 40,302)
Attorney for Applicants

Human Genome Sciences, Inc.
9410 Key West Avenue
Rockville, MD 20850
(301) 309-8504 (telephone)

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